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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,317	06/23/2006	Yoshihiro Okada	292829US0PCT	9081
22850	7590	06/11/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			BADR, HAMID R	
1940 DUKE STREET				
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			06/11/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/584,317	<b>Applicant(s)</b> OKADA ET AL.
	<b>Examiner</b> HAMID R. BADR	<b>Art Unit</b> 1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 23 June 2006 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/IS/02)  
     Paper No(s)/Mail Date 0/23/2006, 9/1/2006.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 is indefinite for "hot water". It is not clear at what temperature the water is considered hot. It is not clear what is meant by "hot water".

4. Claim 1 is also indefinite for "a germination step". It is not clear what is meant by "a germination step". It is not clear whether the germination step is a part of the process of claim 1 or it could be any germination step separate from the process of claim 1.

5. Claim 2 is indefinite for "a mixing ratio of the malt". It is not clear what is meant by "a mixing ratio of the malt". It is not clear whether the mixing ratio is the ratio of malt to the food product to which the malt is added.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Jodlbauer (US 6,120,908; hereinafter R1).

8. R1 discloses a method for producing a flour consisting of two flours. One of these flours is prepared by soaking wheat grains in water, followed by germination of the soaked grains and drying followed by grinding the germinated material. (Abstract)

9. R1 discloses the details of the softening phase (soaking in water), germination phase and drying phase. (Col. 3, lines 15-55).

10. R1 discloses the incorporation of the malted wheat grains into regular flour for baking purposes. (Col. 4, Example 1, and 2)

11. Based upon the fact that the reference discloses all of the claimed components in a process for making malted grains, it would be expected that the malting enzymes and disclosed composition would necessarily provide the oligosaccharides as presently claimed, i.e., the malt prepared by the method as disclosed by R1 will inherently contain oligosaccharides.

12. **Claims 1and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-2002-095443; Machine Translation, hereinafter R2.**

13. R2 discloses malting of black wheat grain [0007]. R2 also disclose the process of drying and grinding the black wheat malt. [0008]. R2 then prepares drinks or baked goods in which the black wheat malt has been incorporated. [0009]

14. Based upon the fact that the reference discloses all of the claimed components in a process for making malted grains, it would be expected that the malting enzymes and disclosed composition would necessarily provide the oligosaccharides as presently

claimed, i.e., the malt prepared by the method as disclosed by R2 will inherently contain oligosaccharides.

15.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jodlbauer (US 6,120,908; hereinafter R1).

18. The disclosure by R1 regarding claim 1 is hereby incorporated by reference as outlined in paragraphs 8-10 above.

19. While R1 is silent regarding the mixing ratio of the malt and the flour to which it is added, it is obvious that the oligosaccharide content of the food can be adjusted by changing the ratio of the malted grain to the food to which it is added.

20. Given that malting will activate the natural enzymes such as  $\alpha$ -amylase in the grain and given that the action of  $\alpha$ -amylase on starch will generate oligosaccharides, the products of the enzymatic hydrolysis will intrinsically include the oligosaccharides as presently claimed.

21. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to prepare a cereal grain malt and incorporate it into foods as taught by R1. One would do so to incorporate natural enzymes and some

oligosaccharides into foods for various purposes. Absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in preparing cereal grain malt and incorporate it into foods.

**22. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2002-095443; Machine Translation, hereinafter R2.**

23. The disclosure by R2 regarding claim 1 is hereby incorporated by reference as outlined in paragraphs 13-14 above.

24. While R2 is silent regarding the mixing ratio of the malt and the food to which it is added, it is obvious that the oligosaccharide content of the food can be adjusted by changing the ratio of the malted grain to the food to which it is added.

25. Given that malting will activate the natural enzymes such as  $\alpha$ -amylase in the grain and given that the action of  $\alpha$ -amylase on starch will generate oligosaccharides, the products of the enzymatic hydrolysis will intrinsically include the oligosaccharides as presently claimed.

26. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to prepare a cereal grain malt and incorporate it into foods as taught by R2. One would do so to incorporate natural enzymes and some oligosaccharides into foods for various purposes. Absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in preparing cereal grain malt and incorporate it into foods.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAMID R. BADR whose telephone number is (571)270-3455. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hamid R Badr  
Examiner  
Art Unit 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794